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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,030	11/04/2003	Thomas L. Kelly	KES-0004	6735
23413	7590	06/17/2009		
CANTOR COLBURN, LLP 20 Church Street 22nd Floor Hartford, CT 06103			EXAMINER A, PHI DIEU TRAN	
			ART UNIT 3633	PAPER NUMBER
			NOTIFICATION DATE 06/17/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/702,030	<b>Applicant(s)</b> KELLY, THOMAS L.	
	<b>Examiner</b> PHI D. A	<b>Art Unit</b> 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13, 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/5/09 has been entered.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1, 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Francovitch (4631887).

Francovitch (figure 1) shows a method for reducing damage in a roof membrane of a roof substrate caused by hail/fastener impact comprising: locating fasteners(75) in a roof construction such that a top of said fastener is exposed at a top surface of the roof substrate (21), positioning at least two individual pieces of energy absorbing material(33, 40) to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by both of said at least two pieces, said at least two pieces including a first piece (40) that is positioned and dimensioned to directly contact said top of said fastener (figure 1), such that said first piece is positioned and dimensioned to cover a substantial entirety of no other roofing component; and

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affixing said first piece to said top of fastener; affixing a second piece(33) of said at least two individual pieces of energy absorbing material to a relative top of said first piece, positioning a roof waterproofing membrane( M) atop all forgoing elements, the one or more layer of roof material including insulation.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly (4441295) in view of Resan and Alexander.

Kelly (figure 1) shows a method for reducing damage in a roof membrane of a roof substrate caused by hail/fastener impact comprising: locating fasteners(13, 154) in a roof construction such that a top of said fastener is exposed at a top surface of the roof substrate, positioning a roof waterproofing membrane (11) atop the fasteners, the one or more layers including insulation.

Kelly does not show the step of positioning at least one individual piece of energy absorbing material to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by the first piece, said at least one piece including a first piece that is positioned and dimensioned to directly contact said top of said fastener, such that said first piece is positioned and dimensioned to cover a substantial entirety of no other roofing

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component; and affixing said first piece to said top of fastener; affixing the first piece to the top of the fastener, affixing a second piece to a relative top of the first piece.

Resan shows the step of positioning a first piece (18) atop a fastener, said at least one piece including a first piece that is positioned and dimensioned to directly contact said top of said fastener.

Alexander shows the step of positioning at least one individual piece of energy absorbing material to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by the first piece, affixing the first piece to the top of the fastener, affixing a second piece to a relative top of the first piece, the affixing is by adhering, the adhering is by a self stick adhesive applied to the energy absorbing material.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kelly's structures to show the step of positioning a first piece atop a fastener, said at least one piece including a first piece that is positioned and dimensioned to directly contact said top of said fastener as taught by Resan in order to provide extra protection for the top of the fastener underneath the membrane, and having the step of positioning at least one individual piece of energy absorbing material to discretely cover each individual fastener of said fasteners whereby said fastener is completely covered by the first piece, affixing the first piece to the top of the fastener, affixing a second piece to a relative top of the first piece to Kelly's modified structure as taught by Alexander would provide further protection for the fastener and its penetrated opening.

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Kelly as modified further shows said first piece is positioned and dimensioned to cover a substantial entirety of no other roofing component; and affixing said first piece to said top of fastener.

Per claim 2, Kelly as modified further shows the affixing is by adhering, the adhering is by a self stick adhesive applied to the energy absorbing material.

Per claims 6, 9, Kelly as modified further shows the material being cover tape, the tape is self-adhesive tape.

3. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly in view of Resan and Alexander (5204148).

Kelly as modified shows all the claimed limitations except for the cover tape composed of cured ethylene propylene diene monomer (EPDM) membrane with a butyl gum rubber bottom, wherein said cover tape is ethylene propylene diene monomer.

Alexander (lines 12-26, column 5) further discloses a tape composed of cured ethylene propylene diene monomer (EPDM) membrane with a butyl gum rubber bottom, wherein said cover tape is ethylene propylene diene monomer

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kelly's modified teaching to show the a tape composed of cured ethylene propylene diene monomer (EPDM) membrane with a butyl gum rubber bottom, wherein said cover tape is ethylene propylene diene monomer as taught by Alexander in order to provide for quick, effective sealing of the fasteners.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly (4441295) in view of Resan (4841706).

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Kelly shows a roof system with reduced hail/fastener impact damage characteristics comprising: a roof substrate(9) having one or more layers of material; at least one top of at least one fastener(13, 15) exposed at a top surface of said substrate; a roof waterproofing membrane (11) positioned over said at least one fastener (13, 15),

Kelly does not show at least two individual piece of energy absorbing material (3, 2) positioned atop all forgoing elements and any-said waterproofing membrane to discretely cover said tops of each individual fastener of said at least one fasteners, said at least two pieces including a first piece(3) that is positioned and dimensioned directly over said top of said fastener, such that said first piece is positioned and dimensioned to cover a substantial entirety of no other roofing component, and said at least two pieces including a second piece ( 2) that is affixed to a relative top of said first piece, an adhesive applied to the first piece and said second piece, the adhesive adhering the first piece to the second piece, the first piece to the waterproofing membrane,

Resan discloses at least two individual piece of energy absorbing material (16, 14) positioned atop all forgoing elements and any-said waterproofing membrane to discretely cover said tops of each individual fastener of said at least one fasteners, said at least two pieces including a first piece(16) that is positioned and dimensioned directly over said top of said fastener, and said at least two pieces including a second piece ( 14) that is affixed to a relative top of said first piece, an adhesive(36) applied to the first piece and said second piece, the adhesive adhering the first piece to the second piece, the first piece to the waterproofing membrane.

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It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kelly's structure to show at least two individual piece of energy absorbing material (16, 14) positioned atop all forgoing elements and any-said waterproofing membrane to discretely cover said tops of each individual fastener of said at least one fasteners, said at least two pieces including a first piece(16) that is positioned and dimensioned directly over said top of said fastener, and said at least two pieces including a second piece ( 14) that is affixed to a relative top of said first piece, an adhesive(36) applied to the first piece and said second piece, the adhesive adhering the first piece to the second piece, the first piece to the waterproofing membrane as taught by Resan in order to provide extra covering for the membrane where fasteners penetrate the roof substrate.

Kelly as modified further shows said at least two pieces including a first piece that is positioned and dimensioned directly over said top of said fastener, such that said first piece is positioned and dimensioned to cover a substantial entirety of no other roofing component.

5. Claims 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly (4441295) in view of Resan (4841706) as applied to claim 13 above and further in view of Alexander ((5204148).

Kelly as modified shows all the claimed limitations except for the energy absorbing material is a cover tape.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kelly's modified structure to show the energy absorbing material is a cover tape as taught by Alexander since it would have been an obvious matter of engineering design



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choice to substitute a rigid covering material with a flexible material as they both provide the same function of protecting the roof at the location where fasteners penetrate.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-9, 13, 15 have been considered but are moot in view of the new ground(s) of rejection.

With respect to Backenstow et al, applicant is correct that the reference does not show the claimed limitations. However, the reference Francovitch which was cited in the same office action, was the intended reference used in the rejection. The rejection of claims 1, 4-5 is clearly demonstrated by the Francovitch as repeated above and set forth in the final office action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Phi D A/  
Primary Examiner, Art Unit 3633

Phi Dieu Tran A

05/26/09